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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/082,527 | 02/22/2002 | Daniel Scott Venolia | 04860.P0539C3 | 8352 |

7590 06/28/2002

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| EXAMINER |
|---|
| BRIER, JEFFERY A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2672 | |

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/082,527 | VENOLIA, DANIEL SCOTT | |
| | Examiner | Art Unit | |
| | Jeffery A. Brier | 2672 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 February 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Priority*

1. The continuing data needs to be updated to reflect the patenting of 09/551,411.

### *Response to Preliminary Amendment*

2. The preliminary amendment filed on 02/22/2002 does not comply with 37 CFR 1.121. Thus, the preliminary amendment has not been entered.

### *Specification*

3. The disclosure is objected to because of the following informalities: a brief description of figure 11 is lacking.

Appropriate correction is required.

### *Drawings*

4. The drawings are objected to because these drawings are copies of the informal drawings filed in the parent applications. They have poor legibility. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Information Disclosure Statement***

5. The information disclosure statement filed on 02/22/2002 provided copies of PTO-892s from the parent applications. The references cited therein have been cited on the accompanying PTO-892. Copies of the references are not being provided since they have been previously provided to applicant.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,061,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are broader than the patented claims.

An analysis of the pending claims and the patented claims follows.

| Pending claim 1 | Patented claim 8 of 6,061,062 |
|---|---|
| 1. A method for accessing a broad data field having fine resolution comprising: | 8. A method of implementing a single input device for controlling movement of a cursor displayed on a computer and for controlling access of a particular piece of data within a data field displayed by a computer system, said method comprising the steps of: |
| | positioning a moveable cursor to a location on a display screen in response to movement of said input device when a signal supplied by said input device is in a first state; |
| | when said signal is in a second state: |
| | remapping control of said input device, wherein movement of said input device controls both a resolution and a range of said data field for display on said display screen rather than positioning said moveable cursor; |
| selecting a first scale from a variable scale for controlling a magnification for accessing data within the data field; | selectively varying said resolution at which said data field is displayed responsive to movement of said input device in a first axis, wherein continuous movement of said input device in said first axis continuously changes said resolution; |
| moving the range to encompass different portions of the data field; and | controlling said range of the data field for display in response to movement of said cursor positioning device in a second axis, wherein continuous movement in the second axis continually causes different ranges of the data field to be displayed; |
| changing simultaneously the scale while moving the range over different portions of the data field. | moving said cursor positioning device in the first and second axes to simultaneously vary said resolution and said range of display, until the particular piece of data is accessed. |

Claims 2-10 correspond to patented claim 8 since they add to pending claim 1 much of the limitations found in patented claim 8.

Claim 11 corresponds to patented claim 9.

| Pending claim 12 | Patented claim 8 of 6,061,062 |
|---|---|
| 12. A method for accessing a particular piece of data within a broad data field having fine resolution comprising: | 8. A method of implementing a single input device for controlling movement of a cursor displayed on a computer and for controlling access of a particular piece of data within a data field displayed by a computer system, said method comprising the steps of: |
| | positioning a moveable cursor to a location on a display screen in response to movement of said input device when a signal supplied by said input device is in a first state; |
| | when said signal is in a second state: |
| | remapping control of said input device, wherein movement of said input device controls both a resolution and a range of said data field for display on said display screen rather than positioning said moveable cursor; |
| selectively varying a scale, thereby determining a range, the range spanning a portion of the data field; | selectively varying said resolution at which said data field is displayed responsive to movement of said input device in a first axis, wherein continuous movement of said input device in said first axis continuously changes said resolution; |
| moving the range relative to the data field, thereby encompassing portions of the data field such that the particular piece of data lies within the range; | controlling said range of the data field for display in response to movement of said cursor positioning device in a second axis, wherein continuous movement in the second axis continually causes different ranges of the data field to be displayed; |
| locating a first point close to the location of the particular piece of data; | |

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| decreasing the scale, thereby increasing the range's resolution, while simultaneously moving the range relative to the data field to keep the first point within the decreased range; | |
| locating a second point which is closer to the location of the particular piece of data than the first point's location; | |
| decreasing the scale while simultaneously moving the range relative to the data field to keep the second point residing within the range; and | |
| successively decreasing the scale while scanning across the range, locating points successively closer to the location of the particular piece of data, and keeping the point that is closest to the location of the particular piece of data within the range, until the particular piece of data is actually accessed. | moving said cursor positioning device in the first and second axes to simultaneously vary said resolution and said range of display, until the particular piece of data is accessed. |

Claims 13-14 correspond to patented claim 1 since they add to pending claim 12 much of the limitations found in patented claim 1.

Claim 15 corresponds to patented claim 10.

| Pending claim 16 | Patented claim 1 of 6,061,062 |
|---|---|
| 16. An apparatus for accessing a broad data field having fine resolution comprising: | 1. In a computer system, a method for accessing a data field comprising the steps of; |
| | positioning a moveable cursor to locations on a display screen in response to movement of a cursor positioning device; |

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| | remapping control of said cursor positioning device from controlling a position of said moveable cursor to controlling both a scale and a segment of said data field for display on said display screen, wherein said cursor positioning device performs a dual function of controlling movement of said cursor and controlling said scale and said segment, depending on a signal indicated by a switch; |
| | when control of said cursor positioning device is remapped: |
| a variable scale for controlling a range within the data field; | increasing said scale at which the data field is displayed according to movement of said cursor positioning device in a first direction of a first axis, wherein sustained movement of said cursor positioning device in said first direction of said first axis continuously increases said scale at which said segment of said data field is displayed; decreasing the scale at which said data field is displayed according to movement of said cursor positioning device in a second direction in the first axis, wherein continuous movement of said cursor positioning device in said second direction of said first axis continuously decreases said scale at which said segment of said data field is displayed; |
| a means for moving the range to encompass different portions of the data field; and | controlling which segment of the data field is displayed according to movement of said cursor positioning device in a second axis, |
| a means for enabling a user to simultaneously select the scale while moving the range over different portions of the data field. | wherein continued movement of said cursor positioning device relative to said second axis causes successive segments of said data field to be displayed at the scale which is selected by movement of said cursor positioning device in said first axis. |

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Claims 17-20 correspond to patented claim 1 since they add to pending claim 12 much of the limitations found in patented claim 1.

Claim 21 corresponds to patented claim 5.

| Pending claim 22 | Patented claim 8 of 6,061,062 |
|---|---|
| 22. A method for accessing a data set containing a plurality of items comprising: | 8. A method of implementing a single input device for controlling movement of a cursor displayed on a computer and for controlling access of a particular piece of data within a data field displayed by a computer system, said method comprising the steps of: |
| | positioning a moveable cursor to a location on a display screen in response to movement of said input device when a signal supplied by said input device is in a first state; |
| | when said signal is in a second state: |
| | remapping control of said input device, wherein movement of said input device controls both a resolution and a range of said data field for display on said display screen rather than positioning said moveable cursor; |
| providing an input device having two degrees of freedom in a first and a second axis; | |
| providing a means for selecting a scale of access to the data set; | selectively varying said resolution at which said data field is displayed responsive to movement of said input device in a first axis, wherein continuous movement of said input device in said first axis continuously changes said resolution; |

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| providing a means for adjusting a position of access at the selected scale; | controlling said range of the data field for display in response to movement of said cursor positioning device in a second axis, wherein continuous movement in the second axis continually causes different ranges of the data field to be displayed; |
| selecting the scale by controlling the input device with relation to the first axis; and selecting the position of access by controlling the input device with relation to the second axis. | moving said cursor positioning device in the first and second axes to simultaneously vary said resolution and said range of display, until the particular piece of data is accessed. |

Claim 23 corresponds to patented claim 10.

Claim 24 corresponds to patented claim 8 since it adds to pending claim 22 a limitation found in patented claim 8.

| Pending claim 25 | Patented claim 8 of 6,061,062 |
|---|---|
| 25. A method for accessing a particular piece of data within a broad data field having fine resolution comprising: | 8. A method of implementing a single input device for controlling movement of a cursor displayed on a computer and for controlling access of a particular piece of data within a data field displayed by a computer system, said method comprising the steps of: |
| | positioning a moveable cursor to a location on a display screen in response to movement of said input device when a signal supplied by said input device is in a first state; |
| | when said signal is in a second state: |
| | remapping control of said input device, wherein movement of said input device controls both a resolution and a range of said data field for display on said display screen rather than positioning said moveable cursor; |

| | |
|---|---|
| providing an input device having a first and a second degree of freedom; | |
| providing a variable scale to depict the data field at different magnification levels, the scale being controlled by the first degree of freedom of the input device; | selectively varying said resolution at which said data field is displayed responsive to movement of said input device in a first axis, wherein continuous movement of said input device in said first axis continuously changes said resolution; |
| providing a range which encompasses a continuous portion of the data set; | controlling said range of the data field for display in response to movement of said cursor positioning device in a second axis, wherein continuous movement in the second axis continually causes different ranges of the data field to be displayed; |
| selecting a scale wherein the particular piece of data lies within the range;<br>decreasing the scale such that the magnification level is increased;<br>changing the span of the data field covered by the range, according to the scale selected;<br>moving the data field such that the particular piece of data falls within the range, the movement controlled by the second degree of freedom; and<br>successively repeating the steps of decreasing the scale and moving the data field such that the particular piece of data falls within the range, until the particular piece of data is actually accessed. | moving said cursor positioning device in the first and second axes to simultaneously vary said resolution and said range of display, until the particular piece of data is accessed. |

From the above comparisons it is clear that the pending claims are broader versions of the patented claims. Broader versions of patented claims are an obvious way for applicant to claim the same thing patented. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 623 (CCPA 1970). Vogel stated on page 623 "*The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. It is further noted that viewing the inventions in reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application.*". Thus, this application's broader claims are not unobvious over the above identified patented claims.

8. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,366,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are broader than the patented claims. By comparing the pending claims with the patented claims it is clear that the pending claims are broader versions of the patented claims. Broader versions of patented claims are an obvious way for applicant to claim the same thing patented. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 623 (CCPA 1970). Vogel stated on page 623 "*The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. It is further*

*noted that viewing the inventions in reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application.".* Thus, this application's broader claims are not unobvious over the above identified patented claims.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 line 5 "the range" lacks antecedent basis in the claim. Claim 3 depends upon claim 2 and claim 2 claimed a cursor while claim 3 claims a cursor as well. It is not clear if the cursor of claim 3 is the same cursor of claim 2 or different cursors. Claim 7 claims six orders of magnitude while the specification at page 2 describes three or five orders of magnitude. It is not clear if applicant meant to claim the claimed six or the described five or three. Claim 10 claims a cursor while claims 2 and 3 also claim a cursor. Claims 4-6, 8 and 9 are indefinite since their parent claims are indefinite and they do not correct the indefiniteness of their parent claims.

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 12-15, 17-21 and 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 12, 17 and 25 claim decreasing the scale until a piece of data is located. The specification described the user as decreasing the scale until the user found the data. The specification does not enable a means or process for decreasing the scale until the means or process has found the data. Claims 13-15 and 18-21 are non-enabled for the same reasons their parent claims are non-enabled and they do not correct the non-enablement of their parent claims.

### *Claim Rejections - 35 USC § 102*

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 11, 12, 16, 17, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthews, U.S. Patent No. 4,794,388.

Matthews describes an input device that allows the user to select the scale (ZOOM) and the range (RANGE) of stored data that will be displayed on the display device in order to allow the user to find stored data the user requires.

Claims 2-7 claim a cursor positioning device as the device for controlling the scale and range.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 2-8, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, U.S. Patent No. 4,794,388.

Claims 2-7 claim a cursor positioning device as the device for controlling the scale and range. Matthews potentiometer 40 looks like a typical joystick which is a well know cursor positioning device. It would have been obvious to one of ordinary skill in the art to have used at the time of filing a cursor positioning device to control scale and range because to control the scale and range only movement in two axis is required the same as to control a cursor.

Claim 8 claims *wherein the range is depicted by a timeline.* The waveform data displayed by Matthews has a timeline (x-axis-time) that represents the range of data points.

Claim 13 claims using a mouse to control the scale and range. This would have been obvious to one or ordinary skill in the art at the time of applicants invention because to control the scale and range only movement in two axis is required the same as to control a cursor with the well known mouse.

Claim 15 claims *wherein the scale is controlled by moving a trackball along an axis and the range movement is controlled by moving the trackball along another axis.* A trackball like the mouse was a well known computer input device at the time of applicants invention. Using a mouse to control the scale and range would have been obvious to one or ordinary skill in the art at the time of applicants invention because to control the scale and range only movement in two axis is required the same as to control a cursor with the well known trackball.

17. Claims 9-10, 14, 18-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, U.S. Patent No. 4,794,388 in view of Becker et al., U.S. Patent No. 5,136,690.

These claims clams using the input device that controls the range and scale in one mode and as an input device that controls the movement of a cursor in another mode.

Matthews does not use the potentiometer 40 to control the movements of a cursor.

Becker shows an input device that controls a cursor which is used to control two different parameters (length of displayed links and range of links-column 1 line 55) used in displaying data from a database.

It would have been obvious to one of ordinary skill in the art at the time of applicants invention in view of both Matthews and Becker to use an input device in one mode to control the range and scale of data displayed from a database and to use the same input device to control the movements of a cursor in a second mode since this would lead to greater user efficiency and ergonomics since the user would not have to leave one input device for another in order to control the different tasks.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Jeffery A Brier
Primary Examiner
Art Unit 2672